

### REMARKS

This Amendment is submitted in response to the Office Action mailed on January 7, 2004. Claims 28-45, 49 and 50 are pending and claim 28 has been amended. Applicants respectfully submit that this application is in complete condition for allowance and request reconsideration of the application in this regard.

Applicants note the Examiner's indication of allowable subject matter in claims 29-35 and the allowance of claims 37-45, 49 and 50. For the reasons stated below, Applicants respectfully submit that claims 28 and 36 are also in complete condition for allowance.

As a preliminary matter, Applicants note that the Examiner incorrectly acknowledged a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f) in the "Office Action Summary." Applicants request that the Examiner take suitable corrective action.

### Priority

Applicants traverse the Examiner's assertion that Applicants have not complied with one or more conditions for receiving the benefit of an earlier filing date under 35 U.S.C. § 120. However, Applicants consider the Examiner's comment that "[t]he subject matter of the '687 application and the '320 application is not commensurate with the present application" to be moot because all claims are allowable over the art of record regardless of which priority date is applied.

**Objection to the Specification**

The specification stands objected to because of the length of the abstract. Applicants have amended the abstract to address this specific informality and, therefore, request that the objection to the specification be withdrawn. Applicants have corrected other typographical and grammatical errors in the specification.

**Rejection of Claims under § 103(a)**

Claims 28 and 36 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Bhat (U.S. Patent No. 5,773,088) in view of Ciardella et al. (U.S. Patent No. 5,505,777). Claim 28 is the only independent claim of the rejected claims. The Examiner admits that Bhat does not teach an electronic control system that controls a transfer system for transferring a plurality of parts to a plurality of treatment positions. The Examiner contends that it would have been obvious to one of ordinary skill in the art to modify Bhat to include such an electronic control system as allegedly taught by Ciardella et al. Applicants respectfully disagree for the reasons set forth below.

Ciardella et al. does not provide a sufficient motivation or suggestion for use of an electronic control system for transferring parts into an evacuated chamber as disclosed by Bhat. Specifically, Ciardella et al. discloses a computer (18) and a conveyor controller (48) used to control a conveyor (22) for transferring substrates individually to a position beneath a viscous material dot generator (12). Bhat discloses introducing a web on a web transfer mechanism (70) through a door into a chamber (66) at col. 5, lines 42-45 and, in an alternative embodiment, through a door into a chamber (132) at col. 7, lines

54-57. Bhat does not require a controller for transferring individual substrates as all substrates (i.e., the rolled web) are transferred simultaneously on the web transfer mechanism (70) into the chamber (66). The rolled web, which constitutes multiple substrates that are coincidentally lengthwise continuous, carried on web transfer mechanism (70) is unwound inside chamber (66) for treatment in treatment zone (82). Individual substrates are not transferred individually into and out of the chamber (66; 132) by the transfer mechanism (70) to a treatment position, as is true in Ciardella et al. Thus, there is no suggestion or motivation to combine the teachings of Ciardella et al. with Bhat to solve a problem that does not exist with Bhat. The mere fact that Ciardella et al. and Bhat may be combined as suggested by the Examiner does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination, which is absent in this instance. Consequently, the Examiner has failed to support a *prima facie* case of obviousness.

Assuming, *arguendo*, that one combined Ciardella et al. and Bhat, the resulting system would not include all the elements of the system of Applicants' claim 28. Specifically, Bhat does not disclose a guide along which each of a plurality of parts is transferred from a position outside of the treatment chamber to treatment positions inside the treatment chamber. Instead, Bhat discloses a guide, identified by the Examiner as rails (168a,b), along which the entire chamber (66; 132) is moved. The individual parts are not moved along the rails (168a,b), as recited in Applicants' claim 28. Instead, the parts remain stationary in Bhat as the chamber (66; 132) is moved along the rails (168a,b).

Moreover, Bhat does not disclose a transfer mechanism operable to transfer the plurality of parts along the guide from a position outside of a treatment chamber to treatment positions within the treatment chamber when the reaction chamber is disengaged from the chamber base, as recited in Applicants' claim 28. Instead, Bhat discloses a transport mechanism (180), as identified by the Examiner, that moves the entire chamber (66; 132) along rails (168a,b) when the chamber and chamber base (68; 138a-c) are disengaged. The transport mechanism (180) does not transfer individual parts along rails (168a,b) from a position outside of the chamber (66; 132) into a treatment position inside the chamber when the chamber and base (68; 138a-c) are disengaged. The web carried on web transfer mechanism (70) remains stationary inside the chamber (66) when the transport mechanism is moving the entire chamber (66). The only transfer of parts in Bhat from outside of the chamber (66; 132) is the introduction of the rolled web carried on a web transfer mechanism (70) through a door in the chamber (66; 132). See col. 5, lines 42-45; col. 7, lines 54-57. The part transfer through this door from a position outside of the chamber (66; 132) to a position inside the chamber is not contingent upon disengaging the chamber from its base (68; 138a-c) and does not occur along the rails (168a,b).

Consequently, even if there were some suggestion or motivation to make the combination proposed by the Examiner with a reasonable expectation of success, the resulting system would not include every element of independent claim 28. All claim elements are significant, and must be given weight. For at least this additional reason, the Examiner has failed to support a *prima facie* case of obviousness.

For at least these reasons, Applicants request that the rejection of independent claim 28 be withdrawn.

As claim 36 depends from independent claim 28, Applicants submit that this claim is also patentable for at least the same reasons. Furthermore, this claim recites a unique combination of elements not taught, disclosed or suggested by the combination of Ciardella et al. with Bhat.

### CONCLUSION

Applicants have made a bona fide effort to respond to each and every requirement set forth in the Office Action. In the event that any issues remain outstanding, the Examiner is invited to contact the undersigned to expedite issuance of this application.

Applicants do not believe that any fees are due in connection with this submission. However, if such petition is due or any additional fees are necessary, the Commissioner may consider this to be a request for such and charge any necessary fees to Deposit Account No. 23-3000.

Respectfully submitted,

WOOD, HERRON & EVANS, L.L.P.



William R. Allen, Reg. No. 48,389

2700 Carew Tower  
441 Vine Street  
Cincinnati, OH 45202  
(513) 241-2324